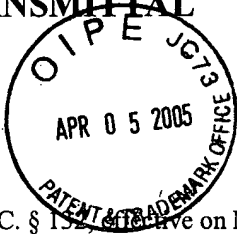


*W. RCE #*

**REQUEST  
FOR  
CONTINUED EXAMINATION (RCE)  
TRANSMITTAL**

**MAIL STOP RCE**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450



Subsection (b) of 35 U.S.C. § 152, effective on May 29, 2000,  
provides for continued examination of an utility or  
plant application filed on or after June 8, 1995

Application Number	09/487,239
Confirmation Number	2929
Filing Date	January 20, 2000
First Named Inventor	Norikane NABATA
Group Art Unit	1771
Examiner Name	Hai VO
Matter Number	Q57646
Title	LAMINATE FOR CONTAINER AND CONTAINER FOR ADSORBENT

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

**1. SUBMISSION REQUIRED UNDER 37 C.F.R. § 1.114**

- a. ☐ Previously submitted
- i. ☐ Please enter and consider the amendment(s)/reply under 37 C.F.R. § 1.116  
previously filed on \_\_\_\_\_
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on \_\_\_\_\_
- iii. ☐ Other \_\_\_\_\_
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☐ Information Disclosure Statements (IDS)
- iv. ☒ Petition for Extension of Time
- v. ☐ Other \_\_\_\_\_

**2. MISCELLANEOUS**

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a  
period of \_\_\_\_\_ months
- b. ☐ Other \_\_\_\_\_

**3. FEES**

A check for the RCE statutory fee of \$790.00 is attached. The USPTO is directed and authorized to charge all  
required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any  
overpayments to said Deposit Account. A duplicate copy of this transmittal letter is attached.

**CORRESPONDENCE ADDRESS**

04/06/2005 1801 Direct all correspondence to the address for SUGHRUE MION, PLLC filed under the Customer Number listed below:

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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

**SIGNATURE OF ATTORNEY**

Name Brian W. Hannon Registration No. 32,778

Signature *Brian W. Hannon* Date April 5, 2005



**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q57646

Norikane NABATA, et al.

Appln. No.: 09/487,239

Group Art Unit: 1771

Confirmation No.: 2929

Examiner: Hai VO

Filed: January 20, 2000

For: LAMINATE FOR CONTAINER AND CONTAINER FOR ADSORBENT

**RESPONSE UNDER 37 C.F.R. § 1.114(c)**

**MAIL STOP RCE**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Advisory Action, Applicants make the following additional arguments concerning the patentability of claims 6 and 8-12 over the combination of Dauber et al and Takiguchi et al.

In the last response, Applicants argued (1) that a person of ordinary skill in the art would not have modified Dauber et al in the manner proposed by the Examiner where the resulting filter includes layers made of two separate materials and (2) that the claimed invention provides unexpected and superior results over the disclosed prior art in that the laminates of the claimed invention exhibit a higher collection efficiency and lower pressure drop than taught or suggested in the prior art.

Applicants thank the Examiner for the detailed response provided in the Advisory Action.

As to the first argument, the Examiner asserts that the teachings in Takiguchi et al of the two layers preferably being made in the same material does not preclude the establishment of a *prima facie* case of obviousness based on the combination of the two references. The apparent reason for this is that the Examiner notes that Takiguchi et al is a secondary reference, not a primary reference.

Applicants respectfully disagree with the Examiner's analysis on this point. Indeed, the law is clear that the entire teachings of both the primary reference and the secondary reference must be considered by the Examiner. Thus, it is simply improper for the Examiner to ignore the teaching in Takiguchi et al that the two layers of the filters should be made of the same material. Taken as a whole, the prior art teaches against the proposed combination.

As to the argument that the claimed invention provides unexpected and superior results not disclosed in the prior art (collection efficiency and reduced pressure drop), the Examiner contends that this argument is not commensurate in scope with the claims because the claims do not recite these two features. Applicants respectfully submit that the Examiner is clearly wrong on this point. There is no requirement that the claims recite the specific unexpected advantages that result from the claimed invention. If the claimed invention provides unexpected and superior results over the prior art, whether those results are claimed or not, then the claimed invention should be patentable over the prior art. On this basis, it is respectfully submitted that the claims should be allowed.

Finally, as to the unexpected advantages achieved by the present invention, the Examiner states that "Applicants should provide evidence or affidavit which shows that the filter of Dauber

fails to meet these novel properties (collection efficiency, pressure drop or moisture permeability)." However, Applicants respectfully note that on its face Dauber makes it clear that it cannot achieve the moisture permeability of the claimed invention.

The Examiner is respectfully referred to col. 6, line 66 to col. 7, line 7 of Dauber. There, Dauber discloses the particle filtration efficiency (collection efficiency) as "in excess of 55% at 0.3  $\mu\text{m}$ ". On the other hand, as indicated in the examples, the claimed invention achieves a collection efficiency not less than 99.9995% at 0.1  $\mu\text{m}$  to 0.2  $\mu\text{m}$ . Thus, the evidence that the Examiner is requesting is specifically described in the Dauber reference. The filter disclosed therein simply fails to meet the collection efficiency of the claimed invention.

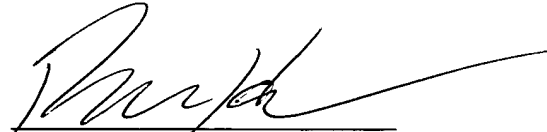
Further, Dauber discloses a pressure drop such as less than 1.0 mm H<sub>2</sub>O at 10.5 feet per minute (3.2 meters per minute) at col. 6, lines 61-65. The pressure drop of the present invention is less than 37 mm H<sub>2</sub>O at 5.3 per sec (please see page 12, line 26 to page 13, line 1 of the subject application). At this point, 10.5 feet per minute is almost equivalent to 5.3 cm per second when converting the scale. Thus, Dauber discloses a lower pressure drop than the claimed invention. That is to say, Dauber fails to teach or suggest a high collection efficiency. Since Dauber does not collect contaminants effectively, the pressure drop of Dauber becomes low.

In view of the foregoing, Applicant respectfully submits that the evidence that the Examiner is requesting is specifically disclosed in Dauber. Thus, from the record before the Examiner, it is clear that the claimed invention provides unexpected and superior results over the cited prior art. Accordingly, it is submitted that the application is in condition for allowance.

RESPONSE UNDER 37 C.F.R. § 1.114(c)  
U.S. Appln. No. 09/487,239

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brian W. Hannon", is written over a horizontal line.

Brian W. Hannon  
Registration No. 32,778

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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: April 5, 2005